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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,071	04/08/2004	Kiyoshi Aida	450100-03204.1	2069

7590 09/11/2006

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EXAMINER
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HWANG, JOON H

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/822,071

Applicant(s)

AIDA ET AL.

Examiner

Joon H. Hwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are ~~withdrawn from consideration~~ *Cancelled*.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/845,136.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/8/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The applicants amended claims 20, 24, and 28 in the supplemental preliminary amendment received on 8/18/05.

The pending claims are 20-31.

***Response to Arguments***

2. Applicant's arguments with respect to claims 20, 24, and 28 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 28-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A program" in 1<sup>st</sup> line of claim 28 is insufficient to render the claims tangibly embodied in a manner so as to be executable. See MPEP 2106 (IV)(B)(1)(a). Since claims 29-31 incorporate the deficiencies of claim 28, they are likewise rejected.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "(means for) **updating** said content of **the database** at any time through the Internet **by connecting said database to said address of the website obtained from the server**" in claims 20, 24, and 31 are not supported by the specification. The specification, page 10, lines 4-7, supports that the server provides updates to the database and page 6, lines 13-16 and page 10, lines 8-16, support that various kind of data related to the media can be obtained by connecting the computer to the website for a user. However, such updating limitation in claims 20, 24, and 31 are not supported by the specification.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yankowski (U.S. Patent No. 5,751,672) in view of Levy et al. (U.S. Patent No. 6,505,160).

With respect to claim 20, Yankowski teaches a database (i.e., a local database 36 in fig. 2) having updatable content containing information relating to a media (i.e., downloading contents updates, lines 18-23 in col. 2 and lines 4-13 in col. 9), searchable by key data generated as a function of information stored at a predetermined place of said media (i.e., fingerprint, lines 37-63 in col. 5 and lines 25-44 in col. 6), said content including an address of a server relating to the media (i.e., a remote database is accessed via Internet, fig. 2, fig. 7, lines 25-67 in col. 2, line 9 in col. 8 thru line 36 in col. 9, and line 44 in col. 11 thru line 57 in col. 12). Yankowski teaches a database can include more detailed information, such as composer, producer, as well as any other information, which might be of value to a user (lines 35-51 in col. 7). Yankowski teaches the database is maintained by commercial ventures or other sources (lines 4-51 in col. 7). Yankowski teaches means for obtaining from the server, through the Internet, information relating to the media (i.e., obtaining information relating to the media from the remote database, lines 4-51 in col. 7). Yankowski teaches means for updating the content of the database at any time through the Internet (i.e., downloading contents updates, lines 18-23 in col. 2 and lines 4-13 in col. 9). Yankowski does not explicitly disclose an address of a website relating to the media. However, Levy teaches an address of a website relating to the media, the website address being different than the server address (lines 38-61 in col. 2, lines 40-61 in col. 4, lines 51-61 in col. 5, lines 43-59 in col. 6, and lines 39-63 in col. 7). Levy teaches means for accessing, through the Internet, the website at the address of the website obtained from the server (lines 38-61 in col. 2, lines 40-61 in col. 4, lines 51-61 in col. 5, lines 43-59 in

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col. 6, and lines 39-63 in col. 7). Levy also teaches means for updating the content of the database at any time through the Internet by connecting the database to the address of the website (i.e., pull model updates, lines 23-49 in col. 11). Therefore, based on Yankowski in view of Levy, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Levy to the system of Yankowski in order to provide an additional opportunity to promote services or goods related to the media to a user.

With respect to claim 21, Yankowski teaches means for inquiring a user, before obtaining more detailed information, whether an access to a server is acceptable (lines 26-65 in col. 8).

With respect to claim 22, Yankowski teaches generating the key data (fingerprint) by calculating a portion of index data (TOC) of the media in a predetermined manner (lines 55-60 in col. 1, lines 34-37 in col. 2, lines 37-63 in col. 5, and lines 25-44 in col. 6).

With respect to claim 23, Levy teaches the website provides a service so that a user can directly purchase another media or good relating to the media via the website (lines 38-61 in col. 2, lines 40-61 in col. 4, lines 51-61 in col. 5, lines 43-59 in col. 6, and lines 39-63 in col. 7). Therefore, the limitations of claim 23 are rejected in the analysis of claim 20 above, and the claim is rejected on that basis.

Claims 24-27 are essentially the same as claims 20-23 except that it sets forth the claimed invention as a method rather than an apparatus and rejected for the same reasons as applied hereinabove.

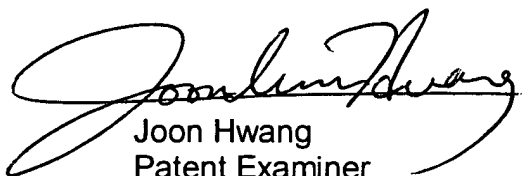
Claims 28-31 are essentially the same as claims 20-23 except that it sets forth the claimed invention as a program rather than an apparatus and rejected for the same reasons as applied hereinabove.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joon Hwang  
Patent Examiner  
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8/31/06